

REMARKS/ARGUMENTS

Claims 2-4 and 6-24 have been cancelled without prejudice or disclaimer of subject matter. Claim 1 has been amended to include the limitations of claim 24 and 26-39 have been newly added; support can be found in the examples.

No new matter has been added.

Claim 24 was previously of record and the newly added claims relate to subject matter previously considered. Accordingly, the amendments do not raise any further search and/or consideration issues. Entry of the amendments is respectfully requested.

Related art rejections

1. The rejection of claims 1-4, 6, 9, 10, 19-22 under 35 USC § 103(a) in view of *Nagano*, in view of JP 09-048989 ("*Seiki*") and further in view of JP 2004-051720 ("*Kamimura*"); the rejection of claims 7 and 8 under 35 USC § 103(a) in view of *Nagano*, *Seiki*, *Kamimura* and further in view of JP 09-222125 ("*Masao*"); the rejection of claims 11-17 under 35 USC § 103(a) in view of *Nagano*, *Seiki*, *Kamimura* and US 2002/0114980 ("*Gunsel*"); the rejection of claims 15-17 under 35 USC § 103(a) in view of *Nagano*, *Seiki*, *Kamimura* and US 5,275,630 ("*Dorer*") and US 5,484,542 ("*Cahoon*"); and the rejection of claim 18 under 35 USC § 103(a) in view of *Nagano*, *Seiki*, *Kamimura* and US 6,586,376 ("*Nakanishi*") have been obviated by amendment.

Claim 1 has been amended to include the limitations of claim 24, which was not included in any of these rejections. Accordingly, claim 1 is now free of these cited references for the same reasons claim 24 is free of these cited references.

Withdrawal of the rejections is respectfully requested.

2. The 35 USC § 103(a) rejection of claims 1, 24, and 25 as being unpatentable over *Seiki* in view of US 6,656,887 ("*Yagishita*") is respectfully traversed.

To establish a *prima facie* case of obviousness against the present claims, the Office must show "a reasonable expectation of success"<sup>1</sup> in regard to the proposed modification to the invention disclosed in the primary reference. In this case, the Office has failed to show or describe any reasonable expectation of success in modifying the *Seiki* greases to include the metal deactivators of *Yagishita*. Rather, the Office merely provides a conclusory statement<sup>2</sup> at paragraph 22 of the Office Action that this proposed modification would have been obvious to the person of ordinary skill in the art at the time the present invention was made.

In view of the foregoing, the Office has failed to establish a *prima facie* case of obviousness against the present claims.

Even if a *prima facie* case of obviousness were to exist, which it does not, Applicant has disclosed results that are not disclosed in the cited references. Results for degreasing efficiencies, among other things, are shown in Table 1 of the present application (reproduced in part from the PGPub of this application and modified for clarity):

			TABLE 1							
			Ex. 1	Ex. 2	Ex. 3	Ex. 4	Ex. 5	Ex. 6	Ex. 7	Ex. 8
Amount (% by mass)	Base oil	A1	91	95.5	97.8	98.9				
		A2					96.9			96.9
		A3						95		
		A4							99.45	
		A5								
	Extreme pressure agent	B1	8	4	2	1	3			3
		B2						2	0.5	
		B3								
		B4								

<sup>1</sup> See MPEP § 2143.02(I.).

<sup>2</sup> See MPEP § 2142.

	Metal deactivator	C1 C2 C3	1	0.5	0.2	0.1	0.1	0.1	0.05	
Lubricity	JASO pendulum Test	Coefficient of friction	0.093	0.097	0.106	0.111	0.103	0.105	0.112	0.117
Degreasing efficiency	Degreasing Test	Residual amount of Oil (g)	0.0057	0.0023	0.0012	0.0006	0.0017	0.0125	0.0516	0.0014
Compati-bility	Compatibility with impreg-nation oil	Precipitates	none	none	none	none	none	none	none	none
	Compatibility with sintered metal	Color change Appearance of oil	none good	none good	none good	none good	none good	none good	none good	none good

The specification states the following in regard to degreasing efficiency:

A sintered metal impregnated with the oil was subjected to extraction with n-hexane. The residual amount of the oil in the sintered metal after the extraction was measured.<sup>3</sup>

The amount of residual oil in the compositions of examples 1-5 and 8, which include dioleyl hydrogen phosphite (*inter alia*) as claimed, was at most 0.0057g after being tested for degreasing efficiency by the test described above (*see* example 1). The amount of residual oil is much less for compositions having the phosphite as claimed, as seen in comparing the data for examples 1-5 and 8 with the data for examples 6 and 7. The compositions of examples 6 and 7 have a phosphate agent, and the amount of residual oil at least an order of magnitude greater than for the compositions having the phosphite as claimed.

There is no disclosure or suggestion in either of *Seiki* and *Yagishita*, individually or combined, of the degreasing efficiencies discussed above. Further, there is no disclosure or suggestion in the cited references, individually or combined, that a phosphite would impart greater degreasing efficiency than a phosphate. Accordingly, Applicant has shown results for the presently claimed compositions that are not disclosed or suggested in the cited references.

In view of the foregoing, the Office has failed to establish a *prima facie* case of obviousness against the present claims, and Applicant has demonstrated results that are not disclosed or suggested in the cited references. Accordingly, the present claims are fully

<sup>3</sup> See the specification at page 13, part (b) of paragraph [0035].

distinguished from the cited references and withdrawal of the rejection is respectfully requested.

Conclusion

Applicants respectfully submit that the above-identified application is in condition for allowance. Notification thereof is requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Ben Vastine', with a long horizontal flourish extending to the right.

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